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01/16/2006 MON 0:24 FAX 801 531 1929 Kunzler and Associates

008/014

## REMARKS

Claims 1-6, 8-20 remain in the case. Claims 1-6, 8-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over United States Patent 5,630,062 issued to Okutsu (hereinafter "Okutsu") in view of United States Patent 6,707,566 to Endoh (hereinafter "Endoh").

Applicant requests that claims 1 and 11 be amended to put the application in condition for allowance, and that claim 3 be amended to correct an informality. The amendments are fully supported by the specification.

### Response to rejections of claims under 35 U.S.C. § 103(a)

Claims 1-6, 8-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Okutsu in view of Endoh. Applicant respectfully traverses these rejections.

With regards to claims 1 and 11, the claims include the limitation of "...mathematically manipulating the unique character string to *generate a printer specific pass code...*" Claim 1. See also claim 11. In contrast, Okutsu does not teach mathematically manipulating the unique character string to generate a printer specific pass code. Applicant agrees that Okutsu uses printer IDs and that these IDs are manipulated. Okutsu discloses using printer IDs from a printer ID table to query the print capabilities of the printers. Okutsu, Col. 7, lines 16-31. Okutsu further teaches assigning a print job to a printer with required print capabilities for printing the print data using the printer ID. Okutsu, Col. 8, line 11-24.

Yet Okutsu does not disclose generating a printer specific pass code. Instead, the manipulations disclosed by Okutsu are carried out to execute a search operation for a printer with a preset group of print capabilities. Okutsu, Col. 7, lines 16-60. Endoh also does not disclose mathematically manipulating the unique character string to generate a printer specific pass code. Because Okutsu and Endoh do not teach generating a printer specific pass code, Applicant asserts that claims 1 and 11 are allowable.

With further regards to claims 1 and 11, the claims include the limitation of "...*enabling a previously disabled printer feature* following the successful validation of the pass code by the printer..." Claim 1. See also claim 11. In contrast, Endoh teaches using a plurality of printer IDs to direct consolidated print instructions to each of a plurality of printers. Endoh, Col. 5, lines 24-45. Endoh does not disclose enabling a previously disabled printer feature. The printer features, such as paper size and/or stapling, that are employed by the printer instructions of Endoh are already enabled and are only activated by print instructions. Endoh, Col. 5, lines 37-45.

Instead, Endoh teaches away from enabling a previously disabled printer feature by stating that "...the printer can be allowed to perform a different printing process according to the processing ability of each printer." Endoh, Col. 5, lines 51-54. Thus Endoh is clearly directed to printer instructions for enabled printer features. Because neither Okutsu nor Endoh teach enabling a previously disabled printer feature, Applicant asserts that claims 1 and 11 are in condition for allowance.

Although Applicant asserts that neither Okutsu nor Endoh teach all of the elements of the claims 1 and 11, Applicant further submits that there is no *prima facie* case of obviousness as there is no suggestion to combine the teaching of Endoh with Okutsu. Even if all the claim limitations are taught or suggested, there must be some suggestion or motivation to combine reference teachings. See MPEP §2142. The Federal Circuit has held that “the ‘subject matter’ that must have been obvious to deny patentability under §103 is the entirety of the claimed invention,” *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1576 (Fed. Cir. 1987). “This ‘as a whole’ assessment of the invention requires a showing that an artisan of ordinary skill in the art at the time of invention, confronted by the same problems as the inventor and with no knowledge of the claimed invention, would have selected the various elements from the prior art and combined them in the claimed manner.” *Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 411 F.3d 1332, 1337 (Fed. Cir. 2005).

Applicant asserts that there is no suggestion or motivation to combine the teaching of Endoh with the teaching of Okutsu. Okutsu discloses a first printer that cannot print received print data transferring the print data to a second printer that can print the print data. Okutsu, Abstract. The motivation for Okutsu is to ensure that a printed job is completed, even if the print job is initially sent to a printer that cannot print the print data. Endoh teaches consolidating print instructions for a plurality of printers to avoid increasing traffic on a network. Endoh, Abstract. Absent the roadmap of the present invention, one of ordinary skill in the art would not combine the teaching of Okutsu with the teaching of Endoh. The teaching of Okutsu and Endoh are

directed to the redirection and consolidation of print instructions respectively, making it unlikely that one skilled in the art would have selected the teaching of Okutsu with Endoh to solve the problem of enabling disabled printer features that is addressed by the embodiment of the present invention.

The Federal Circuit has made it clear that it is "...impermissible to use the claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention." *Uniroyal v. Rudkin-Wiley*, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988) (citing *W. L. Gore & Associates v. Garlock, Inc.*, 220 USPQ 303, 312). Absent a showing that an artisan of ordinary skill in the art at the time of invention, confronted by the same problems as the inventor and with no knowledge of the claimed invention, would have selected the various elements from the prior art and combined them in the claimed manner, Applicant asserts that claims 1 and 11 are allowable as there is no showing or suggestion to combine the teachings of Okutsu and Endoh.

Applicant further asserts that there is no suggestion or motivation to combine Okutsu and Endoh as to combine Okutsu with Endoh would destroy the purpose of both. Endoh teaches combining print commands for multiple printers to reduce bandwidth. Endoh, Abstract, Col. 5, line 55 – Col. 6, line 5, Fig. 6. Supporting the redirection function of Okutsu increases network bandwidth required for a print job, destroying the purpose of Endoh. The Federal Circuit has determined there is no suggestion or motivation to make a proposed modification if the modification would render the prior art unsatisfactory for its intended purpose. *In re Gordon*,

733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Therefore, Applicant asserts that there can be no suggestion or motivation to combine Okutsu and Endoh and that claims 1 and 11 are allowable.

There can also be no suggestion or motivation to combine Okutsu and Endoh as the references mutually teach away from each other. Endoh teaches consolidating print instructions directed to a plurality of printers with known capabilities. Endoh, Col. 1, lines 45-52. The capabilities must be known for the print instructions to be consolidated. In contrast, Okutsu teaches directing print instructions to a first printer that may be unable to print the print instructions or print data. Okutsu, Abstract. If the first printer cannot print the print data, the first printer queries and locates a second printer that can print the print data. Okutsu, Abstract. Thus the invention of Okutsu relies on the print capabilities being initially unknown, teaching away from Endoh.

Applicant further asserts that Okutsu and Endoh are inappropriate references for rejecting the embodiment of the present invention as Okutsu and Endoh are directed to a different field of endeavor. Both Okutsu and Endoh are directed to communicating print instructions whereas the present invention is directed to enabling print features. The present invention may be practiced without communicating print commands, putting the present invention in a different field of endeavor. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977

F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). Applicant therefore asserts that claims 1 and 11 cannot be unpatentable over Okutsu in view of Endoh as the embodiment of the present invention is directed to a different field of endeavor.

In addition, Applicant requests that claims 1 and 11 be amended to more distinctly claim the subject matter of the Applicant's invention. Specifically, Applicant requests that claims 1 and 11 be amended to include the limitation "...wherein the printer specific pass code is differentiated from the unique character string..." Claim 1 and 11 as amended. The amendment is well supported by the specification, which describes addition, subtraction, multiplication, division, and alpha character conversion to generate the differentiated printer specific pass code. Page 9, lines 11-22. The amendment clarifies that the printer specific pass code is distinct from the unique character string, further differentiating the embodiment of the present invention from Okutsu and Endoh. As discussed above, neither Okutsu nor Endoh teach generating a printer specific pass code, and therefore Applicant asserts that claims 1 and 11 as amended are allowable.

With further regards to claim 11, Applicant requests that the claim be amended to include the limitation "...wherein the printer feature remains enabled." Claim 11 as amended. The amendment is well supported by the specification, which states that the method terminates with the enabling of the feature. Page 13, lines 10-12. The amendment clarifies that the enabled printer feature is distinct from the printer instructions of Endoh. As discussed above, Endoh and

Okutsu do not teach enabling a previously disabled printer feature, and Applicant therefore asserts that claim 11 as amended is allowable.

Because Okutsu and Endoh do not teach element of the present invention and because there is no suggestion or motivation to combine Okutsu and Endoh, Applicant asserts that claims 1 and 11 cannot be unpatentable over Okutsu in view of Endoh. In addition, Applicant submits that claims 2-6, 7-10, and 12-20 are allowable as depending from allowable claims.

As a result of the presented remarks, Applicant respectfully asserts that claims 1-6, and 8-20 are in condition for prompt allowance. Should additional information be required regarding the traversal claims enumerated above, Examiner is respectfully asked to notify Applicants of such need. If any impediments to the prompt allowance of the claims can be resolved by a telephone conversation, the Examiner is respectfully requested to contact the undersigned.

Respectfully submitted,



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